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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JEYHAN KARAOGUZ and JAMES D. BENNETT

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Appeal 2009-008208  
Application 10/672,653<sup>1</sup>  
Technology Center 2400

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Before ALLEN R. MacDONALD, MARC S. HOFF, and  
ELENI MANTIS MERCADER, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>2</sup>

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<sup>1</sup> The real party in interest is Broadcom Corporation.

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-25. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellants' invention relates to a system and method for billing and authentication in a media exchange network using either a card or an independent server (Spec. ¶¶ [10]-[13], [28]). The system and method allow a user to access media from more than one communication device (i.e., laptop or set-top box) at different locations (Spec. ¶ [35]; claims 1, 10, 17, 21).

Independent claims 1 and 21 are exemplary:

1. A system for billing and authentication of a communication device in a communication network, comprising:

at least one communication device deployed in at least one location;

a communication network communicatively coupled to the at least one location;

information content residing on one or both of the communication network and the at least one location; and

a card carrying information related to one or more user-defined selections of the information content, wherein the card allows the at least one communication device to access the user-defined selections identified by the card, once the card is communicatively coupled to the at least one communication device.

21. A method for billing and authentication of a communication device in a communication network, comprising:

selecting media exchange services to be provided to a first communication device at a first geographic location and/or a second communication device at a second geographic location, the media exchange services relating to a user-defined selection of information content that is available on the communication network;

establishing a subscription with an independent server located on the communication network, the subscription allowing for access by the first communication device and the second communication device to the selected media exchange services available on the communication network;

entering identification information via the first communication device, the identification information validating the subscription to the selected media exchange services; and

accessing the selected media exchange services by the first communication device after entry of the identification information.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Spies	US 6,055,314	Apr. 25, 2000
Thomas	US 2002/0059621 A1	May 16, 2002
Hendricks	US 7,134,131 B1	Nov. 7, 2006

Claims 1-4, 6-8, and 10-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Spies.

Claims 5 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas and Spies, further in view of Hendricks.

## ISSUES

With respect to claims 1-4 and 6-8, Appellants argue that Thomas and Spies fail to disclose or suggest a card carrying information *related to* user-defined selections (App. Br. 7-10). Appellants contend that the keys or other information stored in Spies's IC card do not identify an actual user-defined selections (Reply Br. 4-5).

Similarly, with respect to claims 17-20, Appellants argue that Thomas and Spies fail to disclose or suggest a card giving access to selected media exchange services on a network, the card carrying information *related to* the selected media exchange services (App. Br. 15-18). In response, the

Examiner asserts that the claim language does not preclude the information on Spies's IC card 50 from being "information related to one or more user-defined selections" (claim 1), and finds that Spies nonetheless teaches information stored on the IC card 50 (such as encryption/decryption information 54 to permit viewing of video content) that is *related to* purchased content, which can be considered user-defined selections (Ans. 4-7, 21-22).

With respect to claims 10-16, Appellants argue that Spies fails to disclose or suggest the independent server that operates upon receipt of authentication and billing information related to payment, billing, or content access (App. Br. 11-14). In response, the Examiner points out that Thomas ([0080]) was relied upon as teaching the authentication feature, and Spies (Figs. 9-11) teaches the billing feature and an independent server 210 (Ans. 10, 23-24).

With respect to claims 21-25, Appellants argue that Thomas and Spies fail to disclose or suggest establishing a subscription with an independent server to allow access by first *and second* communication devices to the selected media exchange services available on the network (App. Br. 18-21). Specifically, Appellants contend that column 13, line 55, through column 14, line 7, of Spies is silent as to providing a subscription that allows access to network services by first and second communication devices, and instead is tied to a single user (App. Br. 20-21; Reply Br. 8-9). In response, the Examiner asserts that ordering a video asset in Spies is equivalent to a subscription where a subscriber purchases a product for a period of time, and does not otherwise explain how Spies's Figure 9 and column 13, line 55, to

column 14, line 7, disclose or suggest providing access to two communication devices.

Appellants' contentions present us with the following issues:

1. Do Thomas and Spies, taken singly or in combination, teach or suggest a card carrying information related to user-defined selections, as recited in independent claims 1 and 17?

2. Do Thomas and Spies, taken singly or in combination, teach or suggest an independent server that provides media exchange services upon receipt of authentication and billing information for user-defined selections, as claim 10 requires?

3. Does Spies disclose or suggest establishing a subscription with an independent server to allow access by first *and second* communication devices to selected media exchange services, as claim 21 requires?

Throughout this decision, we make reference to the Appeal Brief ("App. Br.," filed October 8, 2008), the Examiner's Answer ("Ans.," mailed December 3, 2008), and the Reply Brief ("Reply Br.," filed February 2, 2009) for their respective details.

### FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

#### *Thomas*

1. Thomas teaches a method of purchasing a video-on-demand program using a remote control 300 (Fig. 3). The user selects a video-on-demand program using display screens 450, 500, 550, and 600 (Figs. 4B, 5A, 6A; ¶¶ [0077]-[0079]), and may purchase the program upon

authentication of “the user’s login identification and associated password information” or “[o]ther user identification techniques” (§ [0080]). Upon entering valid login information and pressing purchase button 557, the selected video-on-demand program is authorized for distribution from remote server network 110 (Fig. 1; ¶ [0081]).

### *Spies*

2. Spies teaches an integrated circuit card (IC card 50) or smart card that “is configured with cryptographic functionality to support the secure purchase of the decryption capabilities from the video merchant [24]” (col. 2, ll. 34-36). The IC card is used together with the user’s set-top box or other video computing device to decrypt a selected video content program (col. 2, ll. 36-42). IC card 50 carries public and private encryption keys 54/56 to allow a user at a communication device to purchase a selected video and have the selected video distributed over a network to the user’s communication device (col. 2, l. 54 to col. 3, l. 24; col. 6, ll. 11-58).

3. Spies further teaches that upon receipt of billing and authentication information being entered related to the program requested, the selected program is distributed to the user from the headend server 210 (*see* Figs. 10, 11 (including PIN verification step 302, video selection step 306, download/distribution step 308, authentication step 314, and billing step 316); col. 15, ll. 1-66). A cable operator 202 can “perform the billing and collection tasks resulting from subscriber rentals of video content programs” (col. 14, ll. 5-7).

4. Spies describes a secure video purchase and delivery system (Fig. 9) embodied in an interactive entertainment network system 200 as follows: “system 200 has a cable operator 202 interconnected to multiple

subscribers 204 via an interactive network 206” (col. 13, ll. 58-60). The cable operator 202 provides selected video programs to subscribers 204 via communication over interactive network 206 (col. 13, ll. 64-67). In this manner, video-on-demand is provided to the subscriber’s home (col. 13, l. 67 to col. 14, l. 4).

## PRINCIPLES OF LAW

On the issue of obviousness, the Supreme Court has stated that “[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 419-420.

## ANALYSIS

### § 103 REJECTION OVER THOMAS AND SPIES

We select (i) claim 1 as representative of the group of claims consisting of claims 1-4 and 6-8, (ii) claim 10 as representative of the group of claims consisting of 10-16, (iii) claim 17 as representative of the group consisting of claims 17-20, and (iv) claim 21 as representative of the group of claims consisting of claims 21-25, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).



*Representative Claims 1 and 17*

Appellants' arguments, summarized *supra*, are not persuasive to establish that the Examiner erred in rejecting representative claims 1 and 17 as being taught or suggested by Thomas and Spies. The Examiner finds (Ans. 4-7, 22), and we agree, that Spies teaches a card (i.e., IC card 50) that carries information *related to* (i) user-defined selections of information content (i.e., videos), or (ii) selected media exchange services relating to the user-defined selections of the information content (FF 2). The card carries public and private encryption keys 54, 56 to allow a user at a communication device to purchase a selected video and have the selected video distributed over a network to the user's communication device (FF 2). We agree with the Examiner (Ans. 4-7, 22) that information on a card that is *related to* user-defined selections of information content (i.e., a selected video program) encompasses Spies's encryption/decryption information 54/56 on card 50 which is used for distributing a selected video to a user at the user's set-top box or other computing device.

Because Appellants have not shown that the Examiner erred in rejecting claims 1 and 17 as taught or suggested by Thomas and Spies, we sustain the Examiner's § 103 rejection of claims 1-4, 6-8, and 17-20.

*Representative Claim 10*

Appellants' arguments (App. Br. 11-14), discussed *supra*, are not persuasive to establish that the Examiner erred in rejecting representative claim 10 as being taught or suggested by Thomas and Spies. The Examiner finds, and we agree, that Thomas teaches authentication of a user and, in response to verification, distributing a selected video program from a server 110 (FF 1; Ans. 9-10), and Spies teaches performing billing and

authentication before providing a video encryption key and video download to a user from headend server 210 (FF 3; Ans. 10, 23-24). Thus, Appellants' argument (App. Br. 11-12) that "the combination of Thomas-Spies does not disclose or suggest at least the limitation found in claim 10 of 'the independent server . . . provides media exchange services . . . upon receipt of authentication and billing information for the one or more user-defined selections from the first communication device'" is unpersuasive.

Because Appellants have not shown that the Examiner erred in rejecting claim 10 as taught or suggested by Thomas and Spies, we sustain the Examiner's § 103 rejection of claims 10-16.

*Representative Claim 21*

Appellants' argument (App. Br. 20-21; Reply Br. 8-9) that Thomas and Spies fail to disclose or suggest the feature recited in claim 21 of establishing a subscription with an independent server to allow access by first *and second* communication devices to selected media exchange services is convincing. Specifically, we find that Spies (column 13, line 65 to column 14, line 7) does not disclose, teach, or suggest allowing access by two communication devices using identification information entered at only one location or communication device. Spies only teaches allowing a single subscriber 204 to select and access video programs from a cable operator 202 over network 206 to get video-on-demand at that subscriber's home (FF 4). Appellants are correct (Reply Br. 8-9) that Spies's disclosure only relates to providing access to a single user 204 at a specific communication device (at that user's home), as opposed to first and second communication devices (multiple devices 204 at multiple user's homes) having access based

on the authentication at the first communication device as set forth in claim 21.

Because Appellants have shown that the Examiner erred in rejecting claim 21, we do not sustain the Examiner's § 103 rejection of claims 21-25.

§ 103 REJECTION OVER THOMAS, SPIES, AND HENDRICKS

Appellants only argue that claims 5 and 9 are allowable for the same reasons provided as to claim 1 from which they depend (App. Br. 21). Because we find *supra* that the Examiner did not err in finding parent claim 1 to be taught or suggested by Thomas and Spies, we therefore find no error in the Examiner's § 103 rejection of claims 5 and 9 over Thomas and Spies in view of Hendricks for the same reasons.

CONCLUSIONS

1. Spies teaches a card carrying information related to user-defined selections, as required by claims 1 and 17.

2. The combination of Thomas and Spies teaches or suggests an independent server that provides media exchange services upon receipt of authentication and billing information for user-defined selections, as required by claim 10.

3. Neither Thomas nor Spies disclose or suggest establishing a subscription with an independent server to allow access by first and second communication devices to selected media exchange services, as required by claim 21.

ORDER

The Examiner's rejections of claims 1-20 are affirmed.

The Examiner's rejection of claims 21-25 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

babc

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